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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,549	08/18/2003	Richard Frederick Dechant		1961

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SACRAMENTO, CA 95825

EXAMINER

ANDERSON, JAMES D

ART UNIT	PAPER NUMBER
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1614

MAIL DATE	DELIVERY MODE
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04/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/642,549

Applicant(s)

DECHANT, RICHARD FREDERICK

Examiner

JAMES D. ANDERSON

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim 4 is presented for examination

Applicant's amendment filed 8/11/2006 has been received and entered into the application. Accordingly, claims 1-2 have been cancelled and claim 4 has been added. Claim 3 is indicated as being cancelled but the Examiner cannot find a previous claim set wherein claim 3 was originally presented.

Applicant's arguments have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

In light of the new rejections being applied against the pending claim, this Office Action is **Non-Final**.

Change of Examiner

The examiner assigned to the instant application has changed. The new examiner is James D. Anderson. Contact information is provided at the end of this Office Action.

Informalities

The Specification filed 8/11/2006 was not entered because Applicant did not mark the specification indicating what was being added and/or removed from the previously filed specification.

The purpose of the submitted documents is unclear. If Applicant wants the cited website to be made of record, the website must be submitted on an Information Disclosure Statement. The submitted 6 page paper entitled "Cancer by Viral Infection? A Review and a Different Hypothesis" does not appear to be a published document. If these documents are provided in response to the prior Office Action, the documents should be submitted as evidence in an Appendix to Applicant's response.

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450.

Claim Rejections - 35 USC § 112 (2nd Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 is indefinite for the following reasons:

1) It is unclear to whom the claimed composition is being applied. For example, while the preamble of the claim recites a method of treating carcinomas, melanomas, colorectal cancer, and ovarian cancer, the active method step does not indicate to whom the composition is applied;

2) Applicant's amendment to claim 4 renders the claim unclear as to whether carcinomas, melanomas, colorectal cancer, and ovarian cancer are all intended to be treated simultaneously. Amending the claim to recite a method of treating carcinomas, melanomas, colorectal cancer, or ovarian cancer will overcome this rejection provided there is support for such an amendment in the originally filed disclosure;

3) The distinction between carcinomas and melanomas, colorectal cancer, or ovarian cancer is not clear because melanomas, colorectal cancer, and ovarian cancer are carcinomas; and

4) The limitation, "...for visible cutaneous tumors, the composition is applied directly" is unclear because it is not apparent what the composition is applied directly to. Amending the claim to recite, "...is applied directly to the cutaneous tumor" will overcome this rejection provided there is support for such an amendment in the originally filed disclosure.

Claim Rejections - 35 USC § 112 (1st Paragraph)

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 4 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

To be enabling, the specification of the patent application must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557, 1561 (Fed. Cir. 1993). Explaining what is meant by “undue experimentation,” the Federal Circuit has stated that:

The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification in question provides a reasonable amount of guidance with respect to the direction in which experimentation should proceed to enable the determination of how to practice a desired embodiment of the claimed invention. *PPG v. Guardian*, 75 F.3d 1558, 1564 (Fed. Cir. 1996).¹

The factors that may be considered in determining whether a disclosure would require undue experimentation are set forth by *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 wherein, citing *Ex parte Forman*, 230 USPQ 546 (Bd. Apls. 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,

¹ As pointed out by the court in *In re Angstadt*, 537 F.2d 498 at 504 (CCPA 1976), the key word is “undue”, not “experimentation”.

- 3) the presence or absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art,
- 7) the predictability of the art, and
- 8) the breadth of the claims.

These factors are always applied against the background understanding that scope of enablement varies inversely with the degree of unpredictability involved. *In re Fisher*, 57 CCPA 1099, 1108, 427 F.2d 833, 839, 166 USPQ 18, 24 (1970). Keeping that in mind, the *Wands* factors are relevant to the instant fact situation for the following reasons:

1. The nature of the invention, state and predictability of the art, and relative skill of those in the art

The invention relates to the treatment of carcinomas, melanomas, colorectal cancer, and ovarian cancer comprising applying a composition comprising resorcinol, camphor, sodium sulfathiazole, and propylene glycol.

The relative skill of those in the art is high, generally that of an M.D. or Ph.D. The artisan using Applicant's invention would generally be a physician with a M.D. degree and several years of experience.

That factor is outweighed, however, by the unpredictable nature of the art. It is well established that "the scope of enablement varies inversely with the degree of unpredictability of the factors involved", and physiological activity is generally considered to be an unpredictable factor. See *In re Fisher*, 166 USPQ 18, at 24 (In cases involving unpredictable factors, such as

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most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.), *Nationwide Chemical Corporation, et al. v. Wright, et al.*, 192 USPQ 95 (one skilled in chemical and biological arts cannot always reasonably predict how different chemical compounds and elements might behave under varying circumstances), *Ex parte Sudilovsky* 21 USPQ2d 1702 (Appellant's invention concerns pharmaceutical activity. Because there is no evidence of record of analogous activity for similar compounds, the art is relatively unpredictable) *In re Wright* 27 USPQ2d 1510 (the physiological activity of RNA viruses was sufficiently unpredictable that success in developing specific avian recombinant virus vaccine was uncertain). As illustrative of the state of the art, the examiner cites Sausville *et al.* (Cancer Research, 2006, vol. 66, pages 3351-3354) and Johnson *et al.* (British J. of Cancer, 2001, 84(10):1424-1431).

Sausville *et al.*, cited for evidentiary purposes, teaches that traditionally explored tumor model systems are insufficient to predict how actual human beings will respond to treatment in the clinic (page 3351, left column). Even when drugs with evidence of anticancer activity in preclinical *in vivo* models are given their maximum tolerated dose in humans, they frequently fail to produce useful activity in humans (*id.*). Also, with regard to unpredictability, Johnson *et al.*, also cited for evidentiary purposes, teach that the *in vivo* activity of 39 different agents in a particular histology in a tumor model did not correlate to activity in the same human cancer. *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. Further, the mode of action of anticancer agents is often unknown or very unpredictable and administration of such agents is often accompanied by undesirable side effects.

These articles plainly demonstrate that the art of treating cancer, particularly in humans, is extremely unpredictable, particularly in the case of a single compound or genus of compounds being used to treat any and all cancers.

2. The breadth of the claims

The claims are extremely broad insofar as they disclose the general treatment of carcinomas with the same composition.

3. The amount of direction or guidance provided and the presence or absence of working examples

The application, at present, appears to be purely hypothetical, based on the theory that all cancers are the result of retroviruses. The specification provides no in vitro or in vivo models of cancer that may be used to test the claimed composition for efficacy in the treatment of cancer. The direction concerning treating cancer is found in the specification at pages 2, which merely states Applicant's intention to do so by providing a composition and methods of administration. The claimed composition was not actually tested in any preclinical models of cancer.

In Applicant's response filed 2/15/2006, it is stated that Applicant has cited "four different types of cancer that were successfully treated". However, no evidence of such treatment has been provided. Applicant further asserts that a basal cell carcinoma on his scalp was successfully treated by applying the claimed composition to the wound. However, this is merely anecdotal as no control was used and it does not appear that there was any follow-up examination with a medical doctor confirming that the basal cell carcinoma was treated.

Further, the claimed composition is asserted to be effective when a "saturated cotton swabs" are inserted both sublingually and rectally for 4 to 5 minutes. Such administration is not generally accepted in the art of cancer therapy and as such, evidence that this administration regimen results in clinically effective blood levels of the claimed active agents would be required to substantiate Applicant's assertion that inserting cotton swabs saturated with the claimed composition under the tongue and in the rectum results in clinically relevant concentrations of the active agents.

Further still, since none of the claimed active agents has ever been used to treat any human cancer, how is the skilled physician to know what dose to use for each of these pathologically different cancers and structurally diverse compounds? There are no guidelines for determining the doses needed to treat a carcinoma vs. melanoma vs. colorectal cancer. Are the identical doses to be used for treating these unrelated cancers?

There are no working examples of treatment of any cancer in cells, animals or man. While some cancers may be the result of a retrovirus, there is no evidence of record that antiretroviral therapy is effective to treat cancers. However, even if there was such evidence, there is no evidence that the claimed active agents have antiretroviral efficacy against any retroviruses implicated in cancer.

4. The quantity of experimentation necessary

Because of the known unpredictability of the art (as discussed *supra*) and in the absence of experimental evidence commensurate in scope with the claims, the skilled artisan would not accept the assertion that the instantly claimed composition could be predictably used as a

treatment for carcinomas, melanomas, colorectal cancer, and ovarian cancer as inferred in the claims and contemplated by the specification.

Genentech Inc. vs. Nova Nordisk states, "[A] patent is not a hunting license. It is not a reward for a search but a compensation for its successful conclusion and 'patent protection' is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable" (42 USPQ 2d 1001, Fed. Circuit 1997).

In the instant case, Applicant has presented a general idea that because some cancers may result from retroviruses then carcinomas, melanomas, colorectal cancer, and ovarian cancer must therefore, *a priori*, be treatable by administering a composition comprising resorcinol (antiseborrheic and antiseptic), camphor (a topical analgesic), sodium sulfathiazole (an antibacterial), and propylene glycol (pharmaceutical solvent).

Determining if the claimed composition would treat any particular cancerous disease state would require formulation into a suitable dosage form and subjecting it to clinical trials or to testing in an assay known to correlate to clinical efficacy of such treatment. This is undue experimentation given the limited guidance and direction provided by Applicant. As noted *supra*, even *in vitro* and *in vivo* assays do not always correlate to efficacy in humans and are not generally predictive of clinical efficacy. Further, the claimed administration regimen appears to be one which is not generally recognized in the art of cancer therapy as being clinically effective. In other words, inserting saturated cotton swabs in the rectum and under the tongue for 4 to 5 minutes is not an art-recognized method of administering anticancer agents.

Accordingly, the instant claims do not comply with the enablement requirement of 35 U.S.C. § 112, first paragraph, since to practice the claimed invention a person of ordinary skill in the art would have to engage in undue experimentation, with no assurance of success.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. ANDERSON whose telephone number is (571)272-9038. The examiner can normally be reached on MON-FRI 9:00 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James D Anderson/
Examiner, Art Unit 1614

/Ardin Marschel/
Supervisory Patent Examiner, Art Unit 1614

